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WEISS & MOY PC

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EXAMINER

MCCLELLAN, JAMES S

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GLYN OTTOFY

Appeal 2009-005191
Application 10/705,310
Technology Center 3700

Decided: May 27, 2010

Before, MURRIEL E. CRAWFORD, JOSEPH A. FISCHETTI, and BIBHU R.
MOHANTY, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1-5, 7-16 and 18-20. We have jurisdiction under 35 U.S.C. § 6(b) (2002). An Oral Hearing was held on May 6, 2010.

SUMMARY OF DECISION

We AFFIRM IN PART; 37 C.F.R. § 41.50(b).

THE INVENTION

Appellant claims a system and method for “playing a team gaming tournament that allows players the opportunity to form teams of one or more players in order to allow a team's performance in a card game tournament to be dependent on both the performance of each individual member of the team as well as the number of players on each team.” (Specification 1:5-9)

Claim 11, reproduced below, is representative of the subject matter on appeal.

11. A method for playing a team gaming tournament comprising, in combination, the steps of:
 providing a computer network including a server and at least one end-user computer coupled to said server via a network connection;
 wherein said end-user computer has a graphical display portion adapted to display a browser window;
 displaying a live game of a poker gaming tournament in said browser window;
 permitting a plurality of users to enter said game of said gaming tournament to play against one another;
 forming a plurality of teams of at least one user from said plurality of users entered in said gaming tournament;

sending user input from said plurality of users to said server; and
calculating a placement finish for each of said plurality of teams in said gaming tournament in conformity with a predetermined formula having dependence on both a number of users on each of said plurality of teams and a performance of each said plurality of users.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Marks	5,755,621	May 26, 1998
Walker	6,142,872	Nov. 7, 2000

The following rejections are before us for review.

1. The Examiner rejected claims 1, 4-5, 7, 10-12, 15-16 and 18 as unpatentable under 35 U.S.C. § 102(b) over Walker.
2. The Examiner rejected claims 8-9 and 19-20 as unpatentable under 35 U.S.C. § 103(a) over Walker.
3. The Examiner rejected claims 2-3 and 13-14 as unpatentable under 35 U.S.C. § 103(a) Walker in view of Marks.

ISSUE

Has Appellant shown that the Examiner erred in rejecting claims 1, 4-5, 7, 10-12, 15-16 and 18 as unpatentable under 35 U.S.C. § 102(b) over Walker on the grounds that a person with ordinary skill in the art would understand that bluffing is a required part of the game of poker?

Has Appellant shown that the Examiner erred in rejecting claims 8-9 and 19-20 as unpatentable under 35 U.S.C. § 103(a) over Walker on the ground that a person with ordinary skill in the art would understand that a casino has only a

given number of video poker machines available and this number will limit the number of players who can play?

PRINCIPLES OF LAW

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 827 (1987).

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

FINDINGS OF FACT

We find the following facts by a preponderance of the evidence:

1. Walker discloses

As previously indicated, the present invention may be applied to video poker machines, as well as to the illustrative slot machines 300-303. In a video poker

implementation, the game results of each player on a given team are combined, and the result providing the highest payout, is provided to each of the team members. The game results of each player on a given team may be combined, for example, by compiling the cards from every team player and selecting the hand with the highest possible payout from all of the drawn cards. In a further variation, each of the players on a team are dealt the same hand, and draw additional cards in a conventional manner. The best hand drawn by one of the team players is then selected as the team result. If more than one player on the team gets the same highest payout result, a bonus can be awarded to the team. In this manner, a team strategy where every player always picks a different draw combination than the other players is discouraged.
(Col. 16, ll. 39-55)

2. The Fitzhugh Declaration states: “The explosion in popularity that has occurred with live poker is in large part due to the ability for one player to “bluff” another player.” (Declaration, ¶2)

3. The Examiner found that “Walker does disclose player caps for the maximum number of players for increased security, as well as maintaining a manageable number of players per team.” (Answer 5)

ANALYSIS

As we explain below, we find claims 1-5, and 7-10 are directed to nonstatutory subject matter. That finding is dispositive of the patentability of these claims. Accordingly, we do not reach the prior art rejection of claims 1-10. *Cf. Ex parte Gutta*, 93 USPQ2d 1025, 1036 (Bd. Pat. App. & Int. 2009) (precedential):

As to these prior art rejections, our decision is dispositive with respect to patentability since (1) claims 1, 3-9, 11-14, 16-19, and 21-23 on appeal do not recite patent-eligible

subject matter under § 101, and (2) we cannot determine the scope of claim 20. We therefore need not reach the question of whether claims 1, 3-7, 9, 11, 12, 14, 16, 17, and 19-23 would have been anticipated under § 102 and claims 8, 13, and 18 would have been obvious under § 103. *See Diehr*, 450 U.S. at 188; *Comiskey*, 554 F.3d at 973 (declining to reach obviousness rejection on appeal after concluding many claims were nonstatutory under § 101); *Bilski*, 545 F.3d at 951 n.1 (noting that § 101 is a threshold requirement and that Examiner may reject claims solely on that basis); *In re Rice*, 132 F.2d 140, 141 (CCPA 1942) (finding it unnecessary to reach rejection based on prior art after concluding claims were directed to nonstatutory subject matter). *See also In re Steele*, 305 F.2d 859, 862 (CCPA 1962) (supporting not presenting an art rejection when considerable speculation into the scope of the claim is required).

We affirm the rejections of claims 11, 12, 15, 16 and 18-20.

With regard to the independent claims 11 and 12, Appellant argues that Walker does not disclose live poker “where players compete against other players, as opposed to competing against machines - players have the ability to bluff or deceive other players.” (Appeal Br. 11) We disagree with Appellant because Walker discloses players competing against other players. Walker specifically discloses competition in that as among team members, “[t]he best hand drawn by one of the team players is then selected as the team result.” (FF 1) Even still, Walker discloses awarding multiple prizes to plural players on the same team “[i]f more than one player on the team gets the same highest payout result, a bonus can be awarded to the team.” (FF1) Appellant’s argument to the issue of Walker not having bluffing fails from the outset because a player is not required to bluff as part of the rules in poker, and bluffing does not appear in the claims and is not

commensurate with the broader scope of the claims which merely recites a live game of poker. *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982).

Likewise, with regard to Appellant's submission of the Fitzhugh Declaration, we find that the declaration fails to establish a nexus between the claim language and proffered evidence because it too is drawn to the issue of bluffing (FF 2), which we find is not recited in the claims and is based on mere conclusions. For objective evidence to be accorded substantial weight, an applicant must establish a nexus between the evidence and the merits of the claimed invention. *In re GPAC*, 57 F.3d 1573, 1580 (Fed. Cir. 1995). An affidavit fails in its purpose if it recites conclusions and few facts to buttress those conclusions. *In re Brandstadter*, 484 F.2d 1395, 1406 (CCPA 1973).

Representative claim 19 recites in pertinent part *limiting a number of said plurality of players to enter said gaming tournament to a predetermined number*. We find that Walker inherently discloses this feature because the number of video poker machines available at a casino will limit the number of players who can play.

We also affirm the rejections of dependent claims 15, 16, 18-20 since Appellant has not challenged such with any reasonable specificity (see *In re Nielson*, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987)).

Representative claim 13 recites the details of assigning a finish number, assigning a finish equalization number; assigning an equalization number to each of the users; and calculating a placement finish. The Examiner cited to Marks col. 20, ll. 15-22 as disclosing finishing numbers reflecting a win/loss order, or equalization numbers. However, a review of Marks at this section only discloses that the server computer determined the appropriate ranking for all players as each round progresses without mentioning particulars such as how the ranking are

calculated. Appellant challenges the failure of Marks to disclose these limitations. (Appeal Br. 14) We therefore will not sustain the rejection of claims 13 and 14 under 35 U.S.C. § 103(a).

NEW GROUND

Pursuant to 37 C.F.R. § 41.50(b), we enter a new ground of rejection. We reject claims 1-5, and 7-10 as failing to meet the requirements under 35 U.S.C. § 101 because these claims do not recite patentable subject matter because all actions are done through human intervention and thus the method is (1) not tied to a particular machine or apparatus, or (2) does not transform a particular article into a different state or thing. *In re Bilski*, 545 F.3d 943, 961-62 (Fed. Cir. 2008) (en banc).

CONCLUSIONS OF LAW

We conclude the Appellant has not shown that the Examiner erred in rejecting claims 11, 12, 15-16 and 18 as unpatentable under 35 U.S.C. § 102(b) over Walker.

We conclude the Appellant has not shown that the Examiner erred in rejecting claims 19-20 as unpatentable under 35 U.S.C. § 103(a) over Walker.

We conclude the Appellant has shown that the Examiner erred in rejecting claims 13 and 14 as unpatentable under 35 U.S.C. § 103(a) Walker in view of Marks.

We enter a new ground of rejection of claim 1-5, and 7-10 under 35 U.S.C. § 101.

This decision contains new grounds of rejection for claim 1-5, and 7-10 pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner

- (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART; 37 C.F.R. § 41.50(b)

JRG

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